

In the United States
Circuit Court of Appeals
For the Ninth Circuit.

Wilson-Western Sporting Goods Co.,
a corporation,

Appellant and Cross-Appellee,

vs.

George E. Barnhart,

Cross-Appellant and Appellee.

BRIEF FOR APPELLEE AND CROSS-
APPELLANT.

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STATEMENT OF THE CASE.

In this brief plaintiff-appellee will attempt to limit the discussion to matters pertinent to defendant's appeal and not the cross-appeal.

The facts relating to the proceedings in this suit have been fully stated at the beginning of our brief, filed on behalf of cross-appellant, but an abbreviated statement may be made as follows:

This is a suit in equity brought for infringement of Letters Patent No. 1,639,547 and No. 1,639,548, both

issued on the 16th day of August, 1927, to George E. Barnhart. Both patents relate to golf clubs and the claims involved in this appeal particularly refer to the manner of attaching a tapered hollow steel shaft to the head of the club.

The suit was referred to David B. Head as Special Master, who, in his report [Tr. 149] found both of the Letters Patent in suit good and valid in law and claims 11 and 12 of Letters Patent No. 1,639,547 and claim 10 of Letters Patent No. 1,639,548 infringed by defendant, by the sale and offering for sale of one type of golf club shown in defendant's 1930 catalogue, Exhibit 8-B and Exhibit 12. The Master also found that a certain Exhibit 3, did not infringe the said claims.

Exceptions were taken by both plaintiff and defendant to the Master's report and after oral argument the report was confirmed by the Hon. Paul J. McCormick, District Judge for the Southern District of California, Central Division. By stipulation the Master's report was adopted as Findings of Fact and Conclusions of Law. [Tr. 163.]

Defendant presented a motion for a bill of particulars and before filing its bill of particulars the defendant, upon written request of plaintiff (Book of Exhibits, p. 22), furnished plaintiff with copies of its catalogues entitled "The Gateway to Golf" for the years 1929 to 1933, inclusive.

Upon being furnished with the catalogues, just referred to, plaintiff filed its bill of particulars [Tr. p. 13] and

among other things charged infringement of the patents in suit by the golf club illustrated on page 4 of the 1930 edition of "The Gateway to Golf" (Book of Exhibits, p. 17), the golf club illustrated on page 5 of the 1931 issue of "The Gateway to Golf," (Book of Exhibits p. 19) and also the golf clubs illustrated on certain designated pages of the 1932 and 1933 issue of "The Gateway to Golf".

The clubs found to infringe claims 11 and 12 of the first patent and claim 10 of the second patent are those illustrated in the 1930 issue of "The Gateway to Golf" just referred to (Exhibit 8-B, Book of Exhibits, p. 17, and Exhibit 12).

The cross-appeal, by plaintiff, is from the finding of non-infringement of claim 10 of Letters Patent No. 1,639,548, by the golf club exemplified by Exhibit 3.

Appellant's brief is written in such a manner that it is not clear as to just what points the argument is directed, but by a reference to appellant's "conclusion" on page 49 of its brief, it appears that generally, appellant is asking this court to pronounce the claims of the Barnhart patent in suit to be void, first, because they are "anticipated," second, "as not defining invention," and, third, "that there is no infringement" for the reason that "defendant's clubs do not embody the same combination of elements having the same mode of operation or functioning in the same manner as is inherent in the structures disclosed in the Barnhart patents in suit."

ARGUMENT.

POINT I.

The Claim in Issue of Each of the Patents in Suit Are Valid as Embracing Patentable Inventions.

Appellant in its discussion of the patents in suit, beginning with page 6 of its brief, attempts to cloud the issues by repeatedly referring to disclosures in the patents which are not pertinent to an understanding of the invention covered by the respective claims herein involved. We particularly refer to the many references made by appellant in those portions of appellant's brief which discuss the matters particularly illustrated on pages 6a and 6b of that brief, particularly the slotted portion of the shaft and its associated parts including the chamber referred to on the two pages as the "under cut" portion of the hosel. It is a well known rule of patent law that each claim of a patent is considered as setting forth a complete and independent invention. The Master in his report [Tr. p. 157] clearly states the rule in the following words:

"Defendant's contention that the patents are limited to a structure wherein the elements of the claims in issue are used in combination with the undercut socket and slotted shaft does not appear to be well taken. The Patent Office allowed claims including all of the elements described as well as the claims in issue which do not include the undercut socket and the slotted shaft. Again referring to Figure 4 of the first patent, a construction is found wherein the undercut socket and slotted shaft are not used. Claims drawn to subcombinations of elements are

good provided that invention is present in the combination. The claims, being valid, can not be limited by reading additional elements into them.”

The court’s attention is called to claims 11 and 12 of patent No. 1,639,547 held to be infringed, which claims read as follows:

“11. In a golf club, a head member provided with a socket and with a shaft, the latter being secured at its one end within the inner portion of the socket, the portion of the shaft near the outer end of said socket being freely movable within and relative to and about the outer end portion of said socket to prevent buckling of said shaft at the outer end of the socket.

12. In a golf club, a head member provided with a socket and with a shaft, the latter being secured at its one end within the inner portion of the socket, the bore at the outer end of said socket being outwardly divergent forming a fulcrum about which said shaft is flexed longitudinally when striking a ball with the golf club.”

The physical elements in claim 11 are a “head member” having a socket, a shaft secured at “its one end”, the portion of the shaft near the outer end of the socket being “freely movable within and relative to and about the end portion of the socket.” Claim 12 is similar to claim 11 except that the claim defines the outer end of the socket as “being outwardly divergent.”

It will therefore be noted that these claims are not directed to that portion of the disclosures of the patent relating to a shaft that is slotted or to a hosel that is under cut to form a chamber in the hosel coincident with

the slotted portion of the shaft. In other words, these claims are each directed to inventions separate and distinct from those inventions defined in other claims. Several of the other claims refer particularly to these other features, as an example, claim 5, which is particularly directed to the slotted shaft feature.

A reference to Figure 4 of patent No. 1,639,457, hereinafter referred to as the "first patent," shows that this slotted feature so much emphasized by appellant is lacking in the form there illustrated but in both forms illustrated the internal bore at the upper end of the socket is flared outwardly to permit the shaft near the outer end of the socket to be freely movable therein as stated in claim 11 and is particularly that portion of the invention referred to in claim 12 wherein it states that "the outer end of the socket is outwardly divergent."

Appellant in its brief lays great emphasis on that portion of the first patent referring to the objects sought by the inventor and to the use therein of language stating that the shaft is secured at its "extreme end" to the head of the shaft. Attention is called to the fact that the claims do not say "extreme end" but state that the shaft is secured "at its one end." In the first patent on page 2, beginning with line 79, the inventor states with reference to Figure 4, that

"the inner end of the shaft may be secured, if desired, to the head member in any suitable manner."

and later says, beginning with line 102 on the same page, that he does not

"wish to be limited to this particular construction, combination and arrangement, nor to the modifications, but desire to include in the scope of my in-

vention the construction, combination and arrangement substantially as set forth in the appended claims.”

Consequently, in view of the fact that the claim does not say “at the extreme end” but says at “one end” the limitation sought by appellant cannot properly be read in the claim.

In both of defendant’s structures, charged to infringe, the shaft is secured in the head by means of a rivet such as disclosed in Fig. 5 of patent No. 1,639,548, hereinafter referred to as the “second patent,” and in connection with the point at which this rivet is placed in the shaft plaintiff’s own witness [Tr. p. 59], Mr. Horace E. Gillette, stated:

“The function of the rivet in holding the hosel on the shaft is the same whether it was in the identical spot shown in Defendant’s Exhibit H or whether it was lower or higher on the shaft.”

The exhibit just referred to was one produced by defendant and apparently taken from the shelves of the defendant company at the time of the hearing, being substantially like plaintiff’s Exhibit 3.

Mr. William A. Doble, defendant’s expert witness [Tr. p. 108, beginning on the last line], stated:

“Of course, to put a pin through you have to come back far enough to have metal to get it through.”

In other words, the rivet would be through “one end” of the shaft as called for in the claims. The same remarks apply with equal force to the claim involved in the second Barnhart patent, which reads as follows:

“10. In a golf club, a head having a socket, a shaft secured at one end within said socket, the portion of the shaft within the outer end of the socket being movable relative to the latter, and a flexible sealing member positioned at the joint between the outer end portion of said socket and said shaft.”

The reference in the claim to securing the shaft at “one end” according to the specification may be done in any manner to suit conditions. This is stated in the specification, beginning at line 3, on page 2, where it is stated:

“The method of securing the end of the shaft to the head may vary to suit conditions.”

That portion of the claim referring to the shaft within the outer end of the socket being movable relative to the socket is particularly explained on page 2, beginning with line 75, where it states:

“The bores at the outer ends of the ferrules, in Figs. 3 and 4, are tapered outwardly in curved form so as to permit greater longitudinal flexion of the shaft relative to the ferrule.”

(The ferrule referred to in the patent has been referred to throughout the case as the hosel.) Reference to this structure of the hosel, is also found on page 2 of the second patent, beginning with line 93.

The other elements in this claim, that is, the “flexible sealing member,” is particularly referred to, beginning with line 112, on page 2 of the second patent in suit, and particularly lines 117 to 119, where it states:

“or a cap, or washer may be positioned within the end of the ferrule around the shaft.”

Referring to page 1 of the second Barnhart patent among the objects pointed out by the inventor this feature of the shaft being movable in the end of the hosel is particularly referred to beginning with line 45 in the following words:

“seventh, to provide a golf club having a shaft-positioning socket, on its head and a shaft mounted with one end within the socket and shiftable relative to the outer end of the latter, said socket being so constructed as to prevent buckling of the shaft at or near the outer end of the socket,”

The invention to which claim 10 in this patent is directed is to a structure wherein the slots are included or *not included*.

With reference to the “flexible sealing member” in claim 10 which has been referred to throughout the case as a rubber gasket or bushing, appellant, beginning with the third from the last line on page 19 of its brief, states that the rubber bushing is merely for the purpose of ornamenting the club. This statement reads as follows:

“In order to ornament the club, a rubber bushing is inserted in a socket formed in the upper end of the ferrule, and between the ferrule and the shaft. This rubber bushing performs no function whatsoever in defendant’s construction except possibly to protect the pyralin sleeve wrapped around the steel shaft at the lower end of this sleeve and likewise to ornament the appearance of the assembly.”

Regardless of whether appellant did in fact consider a rubber bushing ornamental, plaintiff’s expert, Doble [Tr. p. 103], in discussing the prior art patents, particularly Exhibit J-10, admitted that a bushing made of

“fiberloid” would have the effect of “reducing shock,” and with reference to a rubber sleeve, disclosed in defendant’s Exhibits J-7 and J-8 that it would be “More so, as it is much more resilient than is the fiberloid.” In the quotation from appellant’s brief, just above, appellant also claims that the bushing “performs no function whatsoever in defendant’s construction except possibly to protect the pyralin sleeve.” Mr. Gillette, plaintiff’s own witness, states on page 59 of the transcript: “I don’t think the portion of the rubber that extends down between the hosel and the shaft protects the pyrolyene collar.” Mr. Gillette goes on to say that he did not think that the rubber extending down between the shaft and hosel performs any function, and then immediately after states:

“If we left the rubber out of there, the shaft would bend directly over that edge, without any resistance in the end of the hosel.”

In plaintiff’s brief on cross-appeal, beginning near the end of page 10, is quoted at length a statement appearing on page 17 of the Book of Exhibits, made by appellant in its yearly catalogue called “The Gateway to Golf” for the year 1930. In this statement appellant gives its own definition of the structure of its club and not only states, that

“this invention is so ingeniously worked out that it is possible to obtain this freedom from shock and still have the shaft actually anchored to the club head.”

but also places appellant’s own interpretation on what is meant by the “lower end” of the shaft, when it states

“note that the lower end of the shaft is secured to the hosel not only by a frictional contact but also by

a metal rivet running clear through the shaft and hosel.”

This statement also refers to the upper end of the hosel being shaped to receive “a bushing of specially treated rubber,” and gives the functioning of the rubber bushing in the following words:

“This rubber bushing acts as a shock insulator and also allows a slight independence of movement between the hosel and shaft which results in the much desired effect of torsion found in the finest wooden shafts.”;

in other words, the particular thing that Barnhart, the patentee, was seeking as pointed out on page 1 of the first patent in suit, lines 18 to 23. The full statement, in the catalogue referred to appears in plaintiff’s Exhibit 8-B (Book of Exhibits, p. 17).

The fact that defendant (appellant) adopted and is using the invention set forth in the claims in issue is sufficient in itself to overcome any attacks which may be made by defendant on the patentability of the inventions covered by such claims. Many cases have considered this question, among which are the following:

In the case of *Hallock v. Davidson*, 107 F. 482, the court stated as follows:

“The defendants have themselves contributed to the cogent testimony establishing the excellence of the weeder by copying it in every essential detail. This being the general situation the court is naturally disinclined to relax the rule which makes the patent prima facie evidence of its validity and casts the burden of showing the contrary upon the defendants. *Cantrell v. Wallick*, 117 U. S. 689, 695. 6 Sup. Ct. 970, 29 L. Ed. 1017.”

In the case of *Kclsey Heating Co. v. James Spear Stove & Heating Co.*, 155 F. 976-979, it is stated:

“* * * Affirming as they thus do, in the most pronounced way possible, to its superior merits and their own inability to do better, they cannot well complain if the inventive originality which is claimed for it is held to sufficiently appear.”

At this point it may be mentioned that appellants produced in evidence some 13 prior patents but with respect to these patents the Master stated as follows [Tr. 154]:

“At first glance it would appear that the flaring of the outer portion of the socket would be an obvious way in which to distribute the strain at the point of juncture of the shaft and hosel. However, an examination of the prior art patents does not disclose any suggestion of such a construction. This tends to strengthen the presumption of invention.”

It is this portion of the Master's report that appellant on the first page of its brief only quotes in part. The finding of the Master, just above quoted, is amply supported by appellant's own expert, Doble, as appears on pages 114 and 115 of the transcript.

As stated in the case of *General Electric Co. v. Wagner Electric Mfg. Co.*, 130 F. 772-778:

“The failure of defendants to avail themselves of said earlier devices or improve them, and their bodily appropriation of the patented construction, is most persuasive upon the question of invention.”

Also in the case of *Griswold v. Harker*, 62 F. 389-393, it is stated:

“Actions often speak louder, and frequently more truthfully, than words. It is not impossible that the reason why the appellees are not using the old devices they plead is that the improvements described in this patent have made them useless and unmerchantable. If this is not so, they can abandon the improvements of Selden and Griswold, and go back to the devices they plead.”

Appellant would have us believe that the defendant (appellant) has discontinued clubs like those shown in plaintiff's Exhibit 8-B (1930 catalogue) and Exhibit 3 and gives as an excuse that the breakage was so great as to render the construction impractical, but the evidence clearly shows that the defendant is still selling clubs having the infringing construction referred to, even in what has been referred to as the “Oggmented” club which was first introduced the latter part of 1933 and which was on the market in 1934. Defendant, however, since the suit was brought in its endeavor to find something to take the place of the invention of the claims in suit is also now selling a club having what is called a Croyden shaft, an expensive shaft formed with a bulge in the shaft right above the end of the hosel. However, appellant admitted by its witness Flynn [Tr. p. 67] that the “rubber no-shock” (the infringing club) sold at a higher price than the old style club and that, “The no-shock that I refer to is the rubber collar that is inserted on the shaft.”

POINT II.

Defendant's Type of Club Exemplified by the Illustration in the 1930 Edition of "The Gateway to Golf" (Book of Exhibits, p. 17, Also Exhibit 12) Infringe Claims 11 and 12 of the First Barnhart Patent and Claim 10 of the Second Barnhart Patent.

In view of the fact that plaintiff's (appellee's) charge of infringement of the club designated with plaintiff's Exhibit 3 is fully discussed in the brief filed on behalf of the cross-appellant (plaintiff) herein, appellee will confine the discussion to the question of infringement insofar as it concerns the type of club shown in the 1930 catalogue and Exhibit 12.

As the club shown in the 1930 catalogue is of the same construction as Exhibit 12 we will refer to page 17, of the Book of Exhibits, as illustrating the structure held to infringe. The Master, in his report which has been adopted as findings of fact [Tr. p. 156] describes the infringing club in the following language:

"The shaft is closely fitted in the lower part of the socket and held in place by a pin at about the middle part of the socket. The socket is flared outward at the upper end. This permits the shaft to flex above the closely fitted portion without bending over a sharp edge. A rubber bushing is fitted around the shaft, a portion of the bushing extending down between the shaft and hosel."

The Master then found claims 11 and 12 of the first patent and claim 10 of the second patent infringed by this construction, just above referred to.

Claims 11 and 12 of the first Barnhart patent read as follows:

“11. In a golf club, a head member provided with a socket and with a shaft, the latter being secured at its one end within the inner portion of the socket, the portion of the shaft near the outer end of said socket being freely movable within and relative to and about the outer end portion of said socket to prevent buckling of said shaft at the outer end of the socket.

12. In a golf club, a head member provided with a socket and with a shaft, the latter being secured at its one end within the inner portion of the socket, the bore at the outer end of said socket being outwardly divergent forming a fulcrum about which said shaft is flexed longitudinally when striking a ball with the golf club.”

By reference to the illustration on page 17 of the Book of Exhibits, it will be noticed that the club is provided with a head member having a socket with a shaft in the socket, that the shaft is secured “at its one end” within the inner portion of the socket (see the rivet marked “anchoring” in the illustration) that the shaft near the outer end of the socket is freely movable within and relative to and about the outer end portion of the socket (part in the illustration marked “chamber” permits this movement). Claim 12 is substantially the same except it is limited by describing the outer end of the socket as being outwardly divergent which appears in the illustration as within the walls of the socket forming the “chamber.” In discussing these claims the rubber bushing may be disregarded. Not only is the structure the same as called for in the claims but the function of the parts

is also the same. Not only can this be seen from the illustration but the descriptive matter beside the illustration clearly removes any doubt on these questions. In view of the length of the argument by appellant offering that the shaft is not secured "at one end," the descriptive matter by the illustration states "Note that the *lower end of the shaft* is secured to the hosel," etc. (Italics ours.)

Certainly it is not necessary to quote law to this court in a case where infringement is as clear as here, particularly when the claims read directly on the infringing structure and the infringing structure accomplishes the same purpose and performs the same function in doing so.

Claim 10 of the second Barnhart patent reads as follows:

"10. In a golf club, a head having a socket, a shaft secured at one end within said socket, the portion of the shaft within the outer end of the socket being movable relative to the latter, and a flexible, sealing member positioned at the joint between the outer end portion of said socket and said shaft."

With respect to claim 10, of the second patent in suit, and using the same illustration on page 17, of the Book of Exhibits, the additional feature in the claim over claims 11 and 12, of the first patent, is "a flexible sealing member positioned at the joint between the outer end portion of said socket and said shaft," this is the part marked "rubber bushing" in the illustration which is the identical thing called for in the claim.

Attention is called to the fact that the patents in suit both issued on the same day and that the invention covered by claim 10 of the second patent in suit in fact is the addition of one element, to-wit, the rubber bushing to the

combination set forth in claims 11 and 12 of the first patent. This situation was passed on by the Circuit Court of Appeals for the Second Circuit in the case of *Sandy MacGregor v. Vaco Grip Co.*, 2 F. 2nd. 655 (which case referred to a golf practicing and exercising device), in the following language:

“It seems to us to be beyond dispute, upon the principles involved, that, if the combination a b c when first made by the patentee was invention, and if the addition of the element d adds utility, even though of itself it would not involve invention if compared with the earlier invention of a b c by some one else, yet the patentee is entitled to claims upon a b c and upon a b c d, and the validity of the second claim may rest, in part, upon its inclusion of the invention more broadly stated in a b c. Most naturally these claims would appear as generic and specific in the same patent: but, if the rules of the Patent Office require, or if the patentee desires and the rules of the Patent Office permit, the issue of separate patents to the same inventor, and they are issued the same day, it cannot be said that the one which bears the earlier application date or issue number is part of the prior art as against the other one always assuming that “prior art” is a matter not touching dedication or double patenting. This was the conclusion we reached upon a discussion of the authorities in *Higgin Co. v. Watson*, 263 F. 378, 385.”

This claim 10 of the second Barnhart patent is clearly infringed for the same reasons as pointed out in connection with claims 11 and 12 of the first Barnhart patent.

Conclusion.

The appellee (plaintiff) insofar as defendant's appeal is concerned, submits:

(1) That claims 11 and 12 of the first patent in suit and claim 10 of the second patent in suit are valid as for a patentable invention, and

(2) That such claims are infringed by the structure of defendant's club illustrated in "The Gateway to Golf", Plaintiff's Exhibit 8-B and Exhibit 12.

It is therefore submitted that this court should find infringement of claims 11 and 12 of the first Barnhart patent and claim 10 of the second Barnhart patent and affirm the interlocutory decree herein in that respect, and that with respect to plaintiff's cross-appeal separately submitted by cross-appellant's brief, filed herein, the decree be modified by finding infringement of the said claims by defendant's golf club, Exhibit 3.

Respectfully submitted,

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